

REMARKS

Claims 44-91 are pending in the application. Claims 1-43 were cancelled. Claims 44-91 stand rejected. Applicant herein amends claims 44, 48, 51, 53, 57, 60, 62, 66, 67, 74, 76, 77, 81, and 82. Applicant herein adds new claims 92 – 115. No new matter has been added. Further review and consideration is respectfully requested in view of the clarifying amendments and remarks below.

Claim Rejections – 35 USC § 102

Claims 44-48, 51-57, 61-67, 69-70, 77-82, 84, and 85 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,903,816 (“Broadwin”). Applicant respectfully traverses these rejections.

Claim 44

In regard to claim 44, the Examiner stated in the Office Action that col. 5 lines 6-9 and col. 7, lines 28-31 of Broadwin teach receiving an electronic file, wherein the electronic file includ[es] first content; [and] generating instructions for a set-top box, wherein the instructions for the set-top box are configured to overlay at least a portion of the first content in the electronic file on at least a portion of the second content in the video signal and the instructions for the set-top box are configured to display the first content if the interactive icon is selected.” (Office Action at p. 3). Applicant has amended claim 44 to further clarify Applicant’s techniques and respectfully submits that Broadwin fails to teach or suggest the subject matter of claim 44 as amended. Broadwin states that “audiovisual content may comprise ... programming [] as is normally seen on television [and] ... still video images.” (Broadwin at col. 4 lines 56-59). The broadcast center 100 of Broadwin “includes an application server 104 for creating and/or generating interactive application content.” (Broadwin at col. 5. lines 1-3). In Broadwin, a CPU 314 of a set-top box can execute the “interactive application and generate[] ... one or more selection options to be displayed or overlaid on top of a television program or still image.” (Broadwin at col. 7, lines 25-37). According to Broadwin, “if user input is received in step 428 ... the interactive decoder 140

determines which of the plurality of still video images corresponds to the user selection [and] the interactive decoder 140 captures the still image that is being broadcast on the still image channel ... and displays the still image on the television screen.” (Broadwin at col. 10 lines 16-36) (Emphasis added). More specifically, the still images are loaded from a different channel of the broadcast video signal. If the still image channel is experiencing technical difficulties, then the interactive features will be inoperable. This is in contrast to the method of claim 44, including “receiving an electronic file, wherein the electronic file includes an interactive icon and first content; receiving a video signal including second content;[and] generating instructions for a set-top box, wherein the instructions for the set-top box are configured to overlay the interactive icon in the electronic file on at least a portion of the second content in the video signal and the instructions for the set-top box are configured to display the first content if the interactive icon is selected.” (Emphasis added). More specifically, the content that is to be displayed in response to the selection of an icon is transmitted on the same channel of the broadcast video signal. Accordingly, since Broadwin fails to teach or suggest each and every element of claim 44, Applicant respectfully requests reconsideration of the rejection of 44.

Insomuch as claims 45 – 48, claims 51, and 52 depend directly, or indirectly, from claim 44, they also patentably define over Broadwin for at least the same reason. Accordingly, Applicant respectfully requests reconsideration of the rejection of claims 45 – 48, claims 51, and 52.

Independent claims 53, 62, 77, new claims 92 and 101 include similar elements to those in claim 44 and patentably define over Broadwin for at least similar reasons with respect to claim 44. Accordingly, Applicant respectfully submits that claims 53, 62, 77, and new claims 92 and 101 are in condition for allowance.

Insomuch as claims 54 – 57, 61, 63 – 67, 69-70, 78-82, 84, 85, and new claims 93-96, 98-100, and 102-109 depend directly, or indirectly, from claims 53, 62, 77, new claims 92, or 101, they also patentably define over Broadwin for at least the same reasons. Accordingly, Applicant respectfully requests reconsideration of the rejections of claims 54 – 57, 61, 63 – 67, 69-70, 78-82, 84, 85, and submits new claims 93-96, 98-100, and 102-109 are in condition for allowance.

Claim 47 and 48

Applicant respectfully submits that claims 47 and 48 patentably define over Broadwin for at least one more additional reason than described above with respect to claim 44. In the Office Action the Examiner stated that col. 7, lines 39-41 disclose “instructions for a set-top box are configured to overlay a purchasing screen for purchasing a product on at least a portion of second content in a video signal.” (Office Action at p. 3). Applicant has clarified claim 48 and respectfully submits that Broadwin fails to teach or suggest a first file with first content, “wherein the first content includes a purchasing screen for purchasing the product on at least a portion of the second content in the video signal.” According to Broadwin, a user “may choose a selection or button displayed on the screen to view a linked still image []. The user or viewer may also choose a selection or button to order a product.” (Broadwin at col. 7, lines 48-52). Applicant respectfully submits that Broadwin states that the purchasing screen is a linked still image loaded from a different channel, see, e.g., Broadwin at col. 6, line 26-27 and Broadwin at col. 6, lines 34-35 stating “MPEG stills are transmitted on the one or more still image channels” and “selections may reference other MPEG stills, or may be used to order information or products.” Accordingly, for at least this additional reason Applicant respectfully requests reconsideration of the rejection of claims 47 and 48.

Insomuch as dependent claims 59, 60, 65, 66, 80 and 81 recite elements similar to claims 47 and 48 they too patentably define over Broadwin for at least the same reasons as claims 47 and 48. Accordingly, for at least this additional reason Applicant respectfully requests reconsideration of the rejection of claims 59, 60, 65, 66, 80 and 81.

Claim Rejections – 35 U.S.C. § 103

Claims 49, 58, 68, and 83 stand rejected under 35 U.S.C. § 103(a) over Broadwin in view of U.S. Patent No. 6,219,837 to Yeo.

With respect to claim 49, in the Office Action the Examiner admitted that Broadwin fails to disclose a video signal including a primary video component of a moving video image and a secondary component comprising a static video image. The Examiner alleges that Yeo discloses such a limitation and that it would have been obvious to combine Broadwin and

Yeo “for the advantage of allowing a viewer to view a video summary of a program while simultaneously watching another.” Applicant respectfully disagrees with the Examiner.

First, Applicant respectfully submits that Broadwin in view of Yeo fails to teach or suggest “receiving an electronic file, wherein the electronic file includes an interactive icon and first content; receiving a video signal including second content;[and] generating instructions for a set-top box, wherein the instructions for the set-top box are configured to overlay the interactive icon in the electronic file on at least a portion of the second content in the video signal and the instructions for the set-top box are configured to display the first content if the interactive icon is selected” for the reasons described above with respect to independent claim 44 from which claim 49 depends. Accordingly, Applicant respectfully requests reconsideration of the rejection of claim 49 for at least the reason described above with respect to claim 44.

Moreover, Applicant respectfully submits that the combined disclosures Broadwin and Yeo cannot be said to create a *prima facie* case of obviousness of Applicant’s claim 49. In this regard, the examiner is reminded that, to support such a *prima facie* case of obviousness, he is required to present **reasons** why a person of ordinary skill would find it obvious to select among the disclosures of the various technologies described by the cited references, so as to arrive at Applicant’s claimed invention. See MPEP § 2141:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 1, 14, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that **"rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."** In *re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at 14, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). [Emphasis added]

In the Office Action, the Examiner set forth a conclusory, “bare-bones” rationale for combining the references in the manner proposed to support the rejection. As stated above the Examiner essentially takes the position that the combination of Broadwin and Yeo renders claim 49 unpatentable because the combination would allow a viewer to view a video

summary of a program while simultaneously watching another. But this analysis merely takes the present Applicant's teachings and transforms them into an argument for unpatentability. In other words, the Examiner is saying that it would have been obvious to combine and modify the prior art because the present Applicant has taught that such a system has advantages over the prior art. Applicant respectfully submits that this is not a proper obviousness analysis but rather relies on improper hindsight to select disparate aspects of the prior art and assemble them in the manner recited by Applicant's claims. Accordingly for at least this additional reason Applicant respectfully requests reconsideration of the rejection of claim 49.

Insomuch as claims 58, 68, 83, and new claims 97 and 107 recite similar elements to claim 49 they patentably define over the combination of references for at least the same reasons as claim 49. Accordingly, Applicant respectfully requests reconsideration of the rejections of claims 58, 68, 83.

Claims 50, 59, 71, and 86

Claims 50, 59, 71, and 86 stand rejected 35 U.S.C. § 103(a) over Broadwin in view of Yeo and further in view of U.S. Patent No. 6,339,842 to Fernandez.

Regarding claim 50, the Examiner admitted that Broadwin in view of Yeo fails to teach an electronic file including information about a current event and alleges that col. 2, lines 16-22 teach such a limitation. The Examiner further stated that the reason for modifying Broadwin in view of Yeo and Fernandez was to allow for a "view to view news updates while watching a program." (See, Office Action at p. 5). Applicant respectfully disagrees with the Examiner.

First, Applicant respectfully submit that Broadwin in view of Yeo and Fernandez fails to teach or suggest "receiving an electronic file, wherein the electronic file includes an interactive icon and first content; receiving a video signal including second content;[and] generating instructions for a set-top box, wherein the instructions for the set-top box are configured to overlay the interactive icon in the electronic file on at least a portion of the second content in the video signal and the instructions for the set-top box are configured to display the first content if the interactive icon is selected" for the reasons described above

with respect to independent claim 44 from which claim 50 depends. Accordingly, Applicant respectfully requests reconsideration of the rejection of claim 50 for at least the reason described above with respect to claim 44.

In addition Applicant submits that Fernandez teaches a data source 4 that provides “two-way or interactive access to one or more database, file, directory, or other functionally equivalent data repository site or signal source, accessible or addressable publicly or privately over conventional network 10 such as ... world-wide web... connection equipment for enabling ... TCP/IP.” (Fernandez at col. 2 lines 5-10). Applicant submits that Fernandez teaches sending information about current events over a TCP/IP network connection, not over a broadcast signal. Applicant respectfully submits that the reason provided by the Examiner is insufficient because it fails to address why one of skill in the art would modify a teaching of sending current events via a TCP/IP network connection to arrive at the subject matter of the claim. Applicant respectfully submits that the Examiner has not performed a proper obviousness analysis but rather relies on improper hindsight to select disparate aspects of the prior art and assemble them in the manner recited by Applicant’s claims. Accordingly for at least this additional reason Applicant respectfully requests reconsideration of the rejection of claim 50.

Insomuch as claims 59, 71, 86 and new claim 98, and new claim 110 recite similar elements to claim 50 they patentably define over the combination of references for at least the same reasons as claim 50. Accordingly, Applicant respectfully requests reconsideration of the rejections of claims 59, 71, 86.

Claims 72 and 87

Claims 72 and 87 stand rejected under 35 U.S.C. § 103(a) over Broadwin in view of U.S. Patent No. 6,922,843 to Herrington. Applicant respectfully traverses these rejections. Claim 72 depends from claim 62 and claim 62 states “demultiplexing the broadcast signal to extract the first channel, wherein the first channel includes set-top box instructions, a video signal including second content, and an electronic file including an interactive icon and first content; [and] processing the set-top box instructions to generate a composite signal, wherein the interactive icon in the electronic file is overlaid upon at least a portion of the second content in the video signal, wherein the set-top box instructions are configured to modify the generated composite signal to display the first content if the interactive icon is selected.” Applicant submits these features are absent from Broadwin. According to Broadwin, “if user input is received in step 428 ... the interactive decoder 140 determines which of the plurality of still video images corresponds to the user selection [and] the interactive decoder 140 captures the still image that is being broadcast on the still image channel ... and displays the still image on the television screen.” (Broadwin at col. 10 lines 16-36) (Emphasis added). More specifically, the still images are loaded from a different channel of the broadcast video signal. In contrast, claim 62 states that the first channel includes set-top box instructions, a video signal including second content, and an electronic file including an interactive icon and first content. Applicant submits that Herrington also fails to teach the instant portion of claim 62. Accordingly, for at least this reason Applicant respectfully requests reconsideration of the rejections of claims 72.

Dependent claim 87 recites similar elements to those in dependent claim 72 and patentably define over the combination of Broadwin and Herrington for at least similar reasons as claims 72.

Newly presented claim 111 recites similar elements to claims 72 and 87. Accordingly, Applicant respectfully submits that claim 111 patentably defines over the combination of Broadwin and Herrington for at least similar reasons as claims 72.

Claims 73 and 88

Claims 73 and 88 stand rejected under 35 U.S.C. § 103(a) over Broadwin in view of U.S. Patent Application No. 09/770769 to Keren. Applicant respectfully traverses these rejections. Claim 72 depends from claim 62 and claim 62 states “demultiplexing the broadcast signal to extract the first channel, wherein the first channel includes set-top box instructions, a video signal including second content, and an electronic file including an interactive icon and first content; [and] processing the set-top box instructions to generate a composite signal, wherein the interactive icon in the electronic file is overlaid upon at least a portion of the second content in the video signal, wherein the set-top box instructions are configured to modify the generated composite signal to display the first content if the interactive icon is selected.” Applicant submits these features are absent from Broadwin. According to Broadwin, “if user input is received in step 428 ... the interactive decoder 140 determines which of the plurality of still video images corresponds to the user selection [and] the interactive decoder 140 captures the still image that is being broadcast on the still image channel ... and displays the still image on the television screen.” (Broadwin at col. 10 lines 16-36) (Emphasis added). More specifically, the still images are loaded from a different channel of the broadcast video signal. In contrast, claim 62 states that the first channel includes set-top box instructions, a video signal including second content, and an electronic file including an interactive icon and first content. Applicant submits that Keren also fails to teach the instant portion of claim 62. Accordingly, for at least this reason Applicant respectfully requests reconsideration of the rejections of claims 73.

Dependent claim 88 recites similar elements to those in dependent claim 73 and patentably define over the combination of Broadwin and Keren for at least similar reasons as claims 73.

Newly presented claim 112 recites similar elements to claims 73. Accordingly, Applicant respectfully submits that claim 112 patentably defines over the combination of Broadwin and Keren for at least similar reasons as claims 73.

Claims 74-75 and 89-90

Claims 74, 75, 89, and 90 stand rejected under 35 U.S.C. § 103(a) over Broadwin in view of U.S. Patent Application No. 09/734808 to Catan. Applicant respectfully traverses these rejections. Claim 74 and 75 depend from claim 62 and claim 62 states “demultiplexing the broadcast signal to extract the first channel, wherein the first channel includes set-top box instructions, a video signal including second content, and an electronic file including an interactive icon and first content; [and] processing the set-top box instructions to generate a composite signal, wherein the interactive icon in the electronic file is overlaid upon at least a portion of the second content in the video signal, wherein the set-top box instructions are configured to modify the generated composite signal to display the first content if the interactive icon is selected.” Applicant submits these features are absent from Broadwin. According to Broadwin, “if user input is received in step 428 ... the interactive decoder 140 determines which of the plurality of still video images corresponds to the user selection [and] the interactive decoder 140 captures the still image that is being broadcast on the still image channel ... and displays the still image on the television screen.” (Broadwin at col. 10 lines 16-36) (Emphasis added). In contrast, claim 62 states that the first channel includes set-top box instructions, a video signal including second content, and an electronic file including an interactive icon and first content. Applicant submits that Catan also fails to teach the instant portion of claim 62. Accordingly, for at least this reason Applicant respectfully requests reconsideration of the rejections of claims 74 and 75.

Dependent claims 89 and 90 recite similar elements to those in dependent claims 74 and 75 and patentably define over the combination of Broadwin and Catan for at least similar reasons as claims 74 and 75.

Newly presented claim 113 and 114 recite similar elements to claims 74 and 75. Accordingly, Applicant respectfully submits that claims 113 and 114 patentably define over the combination of Broadwin and Catan for at least similar reasons as claim 74 and 75.

Claims 76 and 91

Claims 76 and 91 stand rejected under 35 U.S.C. § 103(a) over Broadwin in view Catan and U.S. Patent No. 5,490,060 to Malec. Applicant respectfully traverses these rejections. Claim 76 depends from claim 62 and claim 62 states “demultiplexing the broadcast signal to extract the first channel, wherein the first channel includes set-top box instructions, a video signal including second content, and an electronic file including an interactive icon and first content; [and] processing the set-top box instructions to generate a composite signal, wherein the interactive icon in the electronic file is overlaid upon at least a portion of the second content in the video signal, wherein the set-top box instructions are configured to modify the generated composite signal to display the first content if the interactive icon is selected.” Applicant submits these features are absent from Broadwin. According to Broadwin, “if user input is received in step 428 ... the interactive decoder 140 determines which of the plurality of still video images corresponds to the user selection [and] the interactive decoder 140 captures the still image that is being broadcast on the still image channel ... and displays the still image on the television screen.” (Broadwin at col. 10 lines 16-36) (Emphasis added). In contrast, claim 62 states that the first channel includes set-top box instructions, a video signal including second content, and an electronic file including an interactive icon and first content. Applicant submits that Catan also fails to teach the instant portion of claim 62. Applicant additionally submits that Malec fails to teach the instant portion of claim 62. Accordingly, for at least this reason Applicant respectfully requests reconsideration of the rejections of claims 76.

Dependent claim 91 recites similar elements to those in dependent claim 76 and patentably define over the combination of Broadwin, Catan, and Malec for at least similar reasons as claim 76.

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Newly presented claim 115 recites similar elements to claim 76. Accordingly, Applicant respectfully submits that claim 115 patentably defines over the combination of Broadwin, Catan, and Malec for at least similar reasons as claim 74 and 75.

CONCLUSION

Applicant respectfully requests reconsideration of the rejections and that the Examiner issue a prompt Notice of Allowance of all Claims. The Examiner is invited to contact the undersigned to discuss the case at the Examiners convenience.

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